



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,559	07/26/2002	Pi-Chen Chen	17657.52a	1292
22913	7590	11/25/2008		
Workman Nydegger 1000 Eagle Gate Tower 60 East South Temple Salt Lake City, UT 84111				
EXAMINER				
LEE, CHEUKFAN				
ART UNIT		PAPER NUMBER		
2625				
MAIL DATE		DELIVERY MODE		
11/25/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/064,559

**Applicant(s)**

CHEN, PI-CHEN

**Examiner**

Cheukfan Lee

**Art Unit**

2625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5.11 and 13-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5.11 and 13-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

1. Claims 5, 11 and 13-33 are pending. Claims 31-33 are newly added. Claims 5, 11, 15, 21, 24, and 31 are independent.
2. Applicant's arguments with respect to claims 5, 11 and 13-33 have been considered but are moot in view of the new ground(s) of rejection.
3. Claims 5, 11 and 13-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claims 5, 11, 21, and 31 each claim a/the color for which the optical detector has insufficient sensitivity. Similarly, Independent claims 15 and 24 written in means-plus-function format each claim a/the/one or more color for which the means for receiving the imaging light has insufficient sensitivity. The claim limitation is not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Applicant's remark states "[s]upport for the amendments to claims 5, 11, 15, 21, and 24 may be found on page 3, lines 14-17, which state "The light sensitivity of the charge-coupled device 600 is degraded due to different light sensitivity generated for different color ..." (page 11, 3<sup>rd</sup> paragraph of the response filed July 7, 2008). However, the description "The light sensitivity of the charge-coupled device 600 is degraded due to different light sensitivity generated for different color" found in the

"Related Art of the Invention" describes the existing problem of the related art with reference to prior art Fig. 1 (see paragraphs 0008 and 0005), and is not found anywhere in the "Detailed Description" of Applicant's invention. The above limitation of claims 5, 11, 15, 21, 24, and 31 is not described anywhere in the detailed description of the invention. In the descriptions related to the elected invention (Invention III, see Requirement for Restriction/Election mailed Feb. 27, 2006 and Response to Election/Restriction filed March 7, 2006), the terminologies "light intensity" being "insufficient" are used throughout the specification. Paragraph 0035 states "the red light output intensity of the charge-coupled device 1600 is found insufficient after a test, a red light source 1100 is used for compensating such insufficiency." A similar statement is made in that paragraph for green light intensity and blue light intensity. Again, paragraph 0041 states "the light source ... modified to improve the inconsistent intensities of red, green and blue lights". However, the specification does not provide a description of how the "test" is performed and how the test is related to the claimed feature of "insufficient sensitivity of the optical detector" and the claimed feature of "a color for which the optical detector has insufficient sensitivity", or whether a test that results in "insufficient sensitivity of the optical detector" is well-known.

For the above reasons, the invention of claims 5, 11, 15, 21, 24, and 31 and their dependent claims 13, 14, 16-20, 22, 23, 25-30, 32, and 33 is not enabled by the specification.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tanaka et al. (U.S. Patent No. 4,437,112)

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (571) 272-7407. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone

Art Unit: 2625

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cheukfan Lee/  
Primary Examiner, Art Unit 2625